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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 829,631	04 10 2001	David R. Sibley	NIH047.1CPIC1	7640

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EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/10/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/829,631

Applicant(s)

SIBLEY ET AL.

Examiner

Marianne Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

- A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply identified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is identified above, the minimum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period may result in the application becoming ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than the period set by this communication, even if timely filed, may reduce any earned patent term. See 37 CFR 1.100(b)(2).

## Status

- 1) ☒ Responsive communication(s) filed on 10 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are permitted in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 2-10 is/are rejected.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) 1-10 is/are objected to.
- 8) ☐ Claim(s) 1-10 are subject to restriction and/or election requirement.

## Application Paper

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 10 April 2002 is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant cannot request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on 10 April 2002 is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawing(s) are required in reply to this Office action.
- 12) ☐ The oath/declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No.         .  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Drafting Conventions (PTO-648)
- 3) ☒ Information Disclosure Statement (P. 16) Paper No(s)
- 4) ☐ Interview Summary (PTO-413) Paper No(s)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

This application is stated to be a continuation of 08/428,242. This is incorrect. The claims filed in the instant application are not the same as those originally filed in parent application 08/428,242. These new claims do not have apparent support in the original claims or originally filed specification. The originally filed parent specification does not disclose or claim the human and rat nucleotide or protein sequences in terms of the third or sixth transmembrane domains. There is no generic disclosure of serotonin receptors possessing these subsequences. As such, this application is properly considered a continuation-in-part of application 08/428,242. Note that if these claims had been introduced into the parent application they would have been considered to constitute new matter. As such, the claims are given benefit to only the instant filing date, namely 4/10/01.

In addition, the continuing information added by the amendment filed 4/10/01 fails to indicate that PCT/US93/10296 is a continuation-in-part of 07/970,338.

It is noted that while the preliminary amendment filed 4/10/01 states that the sequence listing submitted in the instant application is the same as that filed in parent application 08/428,242 on 2/10/97 this is not completely accurate. Note that the feature fields are not the same and for example, SEQ ID NO: 12 at the nucleotides encoding amino acid 21 lists "Arg" in the present listing and "Xaa" in the parent listing. This is not considered to be new matter as the nucleotides "CGN" would encode Arg for each of CGU, CGC, CGA, and CGG.

In the amendment filed 4/10/01, applicant refers to an interview held on 1/22/01 in parent application 08/428,242 and states that the interview summary is attached. This attachment was not found. The issues in the parent application that led to that interview are summarized below.

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Applicant had submitted a new sequence listing, a new CRF, and the Hamblin declaration to correct the nucleotide sequence of SEQ ID NO: 12 and thus the corresponding protein it encodes, SEQ ID NO: 13. These changes as well as the deposit information inserted into the specification were deemed to be new matter. None of the information provided demonstrated that a material in hand and specifically identified in the specification at the time of filing was resequenced to demonstrate a sequencing error. Page 23, lines 1-5, of both the parent and instant specification makes clear that multiple materials were identified and none were specifically identified as required by MPEP 2406.01. The experimental details concerning the second round of hybridization are not provided. Neither a lambda phage MT1A1 nor ATCC Accession No. PTA-1538 were disclosed in the parent specification as filed. Thus, the requirement for the statement set forth in MPEP 2406.02 when a deposit is made after the filing date has not been met. It is noted that the Hamblin Declaration discussed sequencing errors and corrections thereof generally and did not point out the particular changes in the sequence. It is acknowledged that applicant has provided Exhibits 1 and 2 as well as the Kohen et al. reference in the instant application to make the corrections to the human and rat sequences clearer. The examiner attaches an alignment of the instant SEQ ID NO: 7 with Genbank Accession No. L41147 and an alignment of the instant SEQ ID NO: 12 with Genbank Accession No. L41146 to show the differences (gaps and mismatches) directly. These Genbank Accession Nos. are provided by Kohen et al. (see legend of Figure 1).

#### ***Oath/Declaration***

This application presents claims for subject matter not originally claimed or embraced in the statement of the invention. A supplemental oath or declaration is required under 37

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CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02. Note that this should be a continuation-in-part oath for the reasons set forth above.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sibley et al. (WO 94/10310).

As set forth above, applicant is entitled to benefit of the instant filing date of 4/10/01. As such, Sibley et al. (WO 94/10310) is valid prior art under 35 U.S.C. 102(b).

Sibley et al. discloses cloning and expression of the rat and human St-B17 serotonin receptor. Vectors and host cells are disclosed. The sequences disclosed comprise the third and sixth transmembrane domains as recited in the instant claims. See abstract, claims, and figures.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 7:00 am - 1:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

*Marianne P. Allen*  
Marianne P. Allen  
Primary Examiner  
Art Unit 1631

mpa  
July 9, 2002